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09/473,649	12/28/1999	AMY MULDERRY	07019.0004	1261

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EXAMINER

O CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/28/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/473,649**

Applicant(s)  
**Mulderry et al.**

Examiner  
**O'Connor**

Art Unit  
**3627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on March 6, 2003 (Amendment "A").
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) 10-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 28, 1999 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on March 6, 2003 (Paper N<sup>o</sup> 16), in reply to the Office action mailed December 6, 2002 (Paper N<sup>o</sup> 14).

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

3. The amendment of claims 1 and 7 by applicant in Paper N<sup>o</sup> 16 is hereby acknowledged.

### ***Election/Restriction***

4. This application contains withdrawn claims 10-31, drawn to an invention nonelected with traverse in Paper N<sup>o</sup> 6. A complete reply to this final rejection must include cancellation of the nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Walker et al. (US 5,926,796).

Walker et al. disclose a method of completing a plurality of transactions on a computer network involving at least one customer computer and a plurality of merchant computers, said method comprising the following steps:

transmitting an offer (to buy a single issue of a magazine for a particular price) from a first merchant computer 122 to a customer 110 computer 120 (the computer provided to interface with the customer 110 and process the customer's 110 transactions);

transmitting customer-inputted information (name and method of payment) from the customer computer 120 to the first merchant computer 122 in response to the offer;

utilizing the customer-inputted information to process 1335 the offer, wherein said customer-inputted information contains a payment method (method of payment) and customer identification data (customer name) required by said first merchant to process said offer;

transmitting 1325 to said customer computer 120 a second offer from a second merchant computer 130 (an offer to buy a subscription to the magazine, it being considered inherent that the subscription offers are provided from the magazine publishers to the retailer to sell); and,

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transmitting said customer-inputted information from said first merchant computer 122 to said second merchant computer 130, provided said customer computer 120 accepts said second offer.

Regarding claims 2, 4, 8, and 9, Walker et al. disclose that the step of transmitting an offer is further comprised of the following steps:

sending 370 an offer from said second merchant computer 130 to said first merchant computer 122;

storing 342 said offer on said first merchant computer 122 (see, in particular, Fig. 3); and, presenting said offer 1325 by said first merchant computer 122 to said customer computer 120 (see, in particular, Fig. 13).

Regarding claims 3 and 5, the method of Walker et al. further comprises the following steps: processing said customer-inputted information by said second merchant computer 130; and, causing a predetermined number of issues of a periodical to be delivered 1550 to a customer associated with said customer-inputted information (see, in particular, Figs. 14 and 15).

Regarding claim 6, the method of Walker et al. further comprises the step of automatically debiting a customer account (it being inherent that the publisher maintains an account for each customer containing the number of remaining issues owed to the customer) corresponding to said customer-inputted information after said predetermined number of issues have been delivered (debiting the account of issues-owed by one issue after each additional issue is delivered), provided said customer does not cancel future delivery of said periodical (see, in particular, column 12, lines 6-53).

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***Response to Arguments***

7. Applicant's arguments filed March 6, 2003 have been fully considered but are not persuasive.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., customer inputting information into the customer computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC

May 23, 2003



*Michael Cuff 5/27/03*

**MICHAEL CUFF  
PRIMARY EXAMINER**